

ECK et al.
Serial No.: 10/805,243
Response to Office Action dated February 24, 2005

Remarks

Reconsideration and allowance of the subject patent application are respectfully requested.

By way of expediency, claims 31-45, 50-53, 64, 68 and 69 have been canceled from this application without prejudice or disclaimer. Thus any rejections of these claims are moot. The canceling of these claims does not constitute (and should not be construed to constitute) acquiescence in the propriety of any outstanding rejection of these claims and Applicants reserve the right to pursue the subject matter of these claims in a continuing application.

Claims 17-29, 31-46 and 50-69 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-44 of U.S. Patent No. 6,716,103. For the reasons set forth below, Applicants respectfully request reconsideration of this rejection.

Claims 17-28 correspond to claims 51-62 of parent application no. 09/659,738, which matured into U.S. Patent No. 6,716,103. These claims were the subject of a restriction requirement dated August 7, 2002 (copy attached in Appendix) during the prosecution of the 738 application. 35 U.S.C. 121 prohibits the use of a patent issuing on an application with respect to which a restriction requirement has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. See also MPEP Section 804.01. Consequently, reconsideration of the double-patenting rejection of claims 17-28 is respectfully requested.

Like claim 17, claim 29 calls for transmitting messages via a paging system if sufficient message credits are stored in a memory. Consequently, this claim corresponds to the subject matter that was restricted in the parent 738 application. Reconsideration of the double-patenting rejection of claim 29 is respectfully requested.

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Claims 46, 54-63 and 65-67 are also believed to be distinct from the claims to which the parent 738 application was restricted and reconsideration of the double-patenting rejection of these claims is also respectfully requested.

As noted above, claims 31-45, 50-53, 64, 68 and 69 have been canceled and thus the double-patenting rejection of these claims is moot.

Claims 17-29 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Darling et al. (WO 93/23125) in view of Marrs (U.S. Patent No. 5,376,931). While not acquiescing in this rejection, claims 17 and 29 have been amended. As such, the discussion below makes reference to the amended claims.

Independent claims 17 and 29 each calls for transmitting messages only if sufficient message credits are stored in a memory. Darling et al. contains no disclosure relevant to this feature. Marrs clearly and unambiguously relates to a message debiting system in which debit units are debited from a debit meter to enable presentation of a stored message. However, each of claims 17 and 29 relates to transmitting messages only if sufficient message credits are stored in a memory. Nothing in Darling et al. or Marrs discloses or suggests conditioning the transmitting of messages on sufficient message credits as claimed and consequently the combination of these documents is likewise deficient in this regard. Consequently, the proposed combination of Darling et al. and Marrs would not have made the subject matter of claims 17 and 29 obvious.

Claims 18-28 depend from claim 17 and are believed to be allowable because of this dependency and because of the additional patentable features contained therein.

Claims 27 and 28 were further rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Darling et al. in view of Marrs, and further in view of Taskett et al. (U.S. Patent No. 6,044,247). Taskett et al. is cited for its purported disclosure of a paging card for replenishing a pager account balance. However, the account balance in Taskett et al. relates to accessing voice messages or phone numbers via a call controller 306 and then making telephone calls. Taskett et al. does not cure deficiencies of Darling et al. and Marrs with respect to claim 17 (from which claims 27 and 28 depend) and thus even if the combination were proper, the subject matter of claims 27 and 28 would not have resulted.

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Claims 31, 32, 34, 36-39, 41, 43, 44 and 46 were rejected under 35 U.S.C. Section 102(b) as allegedly being anticipated by Darling et al. Claims 31, 32, 34, 36-39, 41, 43 and 44 have been canceled without prejudice or disclaimer and thus the rejection of these claims is moot.

Claim 46 specifies that the processing system of the hand-held game machine is responsive to a message received over a wireless communication network for disabling radio frequency communication circuitry of the hand-held game machine. In connection with this claim, the office action references page 18, lines 3-8 and page 20, lines 23-28 of Darling et al.

The first referenced portion relates to reverting to stand-alone game player mode "until proper communications can be re-established." First, there is nothing in this referenced portion describing that the radio frequency communication circuitry is disabled. Indeed, to re-establish proper communications as suggested in Darling et al. would require that the communication circuitry be enabled, not disabled. Second, the stand-alone game player mode is described as resulting when there is high transmission error rate, e.g., transmissions cannot be received. Thus, even if the stand-alone player mode is erroneously viewed as involving the disabling of radio communication circuitry, the disabling results from failing to receive a message over a wireless communication network, not in response to receiving one.

The second referenced portion of Darling et al. describes that game software should be designed to ensure continuity of game play should a player drop out of a game. Here again, there is nothing suggestive of disabling communication circuitry in response to a received message. The continuity of the game play may well be dependent on the radio circuitry being enabled if, for example, one player dropped out of a game being played by three or more players. Or, consistent with the first referenced portion, continuity of game play should be maintained while a player who dropped out attempts to re-establish proper communications. Here again, the radio communication circuitry would need to be enabled, not disabled. There is simply no basis for reading the second referenced portion of Darling et al. as describing the disabling of communication circuitry.

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Because Darling et al. fails to disclose disabling radio frequency communication circuitry in response to a message received over a wireless communication network, Darling et al. cannot anticipate claim 46. See, e.g., *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.")

Claim 55 has been amended to incorporate the subject matter of now-canceled claim 64 relating to a storage device for storing user-defined graphics and symbols for composing messages. In connection with this claim, the office action acknowledges that no such feature is disclosed in Darling et al. 2/24/05 Office Action, page 9. Instead, the office action maintains that this feature is an obvious design-choice because, among other things, "applicant has not disclosed that storing user-defined messages solves any stated problem or is for any particular purpose and it appears that the memory 22 in the game machine 10 of Darling et al. would perform equally well storing both predefined messages and user-defined messages." Nothing in 35 U.S.C Section 103 relieves the USPTO of its responsibility to provide evidence of obviousness because of an alleged failure, for example, to disclose that a particular feature solves a problem or is for a particular purpose. There is simply no documentary evidence of record that establishes the obviousness of modifying Darling et al. to provide this feature. As such, claim 55 is believed to be allowable over Darling et al.

Claims 58, 59, 61, 63, 66 and 67 depend from claim 55 and were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Darling et al. in view of Wagner et al., and further in view of Marrs. Wagner et al. and Marrs provide no disclosure relevant to storing user-defined graphics and symbols for composing messages as recited in claim 55. Thus even if Wagner et al. and Marrs would have been combined with Darling et al. for some reason, the subject matter of claims 58, 59, 61, 63, 66 and 67 would not have been made obvious.


Claims 50-54 and 68 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Darling et al. in view of Wagner et al. ("Human Factors Design Guide"). Claims 50-53 and 68 have been canceled and thus this rejection with respect to

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these claims is moot. Claim 54 depends from claim 46. Even if Darling et al. were for some reason provided with a touch-sensitive screen based on Wagner et al. as proposed in the office action, the result would still be deficient with respect to the features of claim 46, from which claim 54 depends. As such, claim 54 is believed to be allowable.

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,738	09/11/2000	Charles P. Eck	723-1088	5699

7590 08/07/2002
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EXAMINER	
CAPRON, AARON J	
ART UNIT	PAPER NUMBER

3714

DATE MAILED: 08/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED

CLT/MATTER # 723-1088
MAIL DATE 8-7-02
DUE DATE Sept 7, 2002
FINAL DEADLINE Feb 7, 2003
DOCKETED BY poe

Office Action **COPY**

Application No.

09/859,738

Applicant(s)

ECK ET AL

Examiner

Aaron J. Capron

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-62 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

MARK SAGER
PRIMARY EXAMINER

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COPY**DETAILED ACTION**

The restriction requirement of the action mailed on May 30, 2002 has been withdrawn. A new restriction is set forth below.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, 17-32 and 37-50, drawn to a game machine cartridge with paging capabilities, classified in class 463, subclass 44.
- II. Claims 12-16 and 33-36, drawn to a game machine cartridge with GPS capabilities, classified in class 463, subclass 39.
- III. Claims 51-62, drawn to charging device and for transmitting user messages, classified in class 463, subclass 25.

Inventions I and II-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions differ since Invention I has the additional feature of allowing the receiver to have, or not, communication capability.

Inventions II and I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the

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different inventions differ since Invention II has the additional feature of allowing the game machine to use positioning data in the execution of the game.

Inventions III and I-II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions differ since Invention III allows a third party to charge the transmission of information from the game machine.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A call to the attorney was not made due to the complicated nature of the restriction.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-F 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-9302 for regular communications and (703) 746-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc
August 6, 2002



MARK SAGER
PRIMARY EXAMINER